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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,605	04/30/2001	Akira Ichikawa	Q64273	9350

7590 08/15/2006

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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,605

Applicant(s)

ICHIKAWA ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' response filed on 7/3/2006 has been entered. Claims 1, 2 and 4-14 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Rejections Based on Prior Art***

3. Claims 1, 2 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission, generally as set forth in section 4 of Office action mailed 3/3/2006.

Tanimura's invention relates to a label comprising an integrated circuit (IC). The IC comprises a memory unit (data carrier element) and a signal processing unit [abstract]. Fig. 2 shows that the adhesive label has an antenna wiring (antenna coil) 30 and an IC 20 formed on a polyimide substrate 16, a "both faces adhesive material" (double sided) adhesive layer 17, and an exfoliative paper (release layer) 18. The adhesive layer 17 adheres the label to a video cassette tape [column 4, lines 7-8]. The label has a coated paper layer 12 as an outer surface layer for carrying information such as the title, recording date, and recording place [column 3, lines 52-56]. A non-contact (contactless) system used for the transfer of data to the semiconductor memory [column 2, lines 15-17]. Tanimura lacks a teaching that the adhesive layer 17 is in direct contact with the IC chip. However, Applicants have admitted in the "Background Art" section that while typically an entire contactless data carrier element is formed on one side of the

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circuit substrate, alternatively the contactless data carrier element may be prepared by separately forming a part of an electric circuit on each side of the circuit substrate, and connecting one to the other via a through-hole, to thus integrate the separately formed parts (electronic components) [specification, pages 1-2, bridging paragraph]. In other words, applicants have admitted that it is known art that the data carrier element containing IC chip can be formed on either side of substrate and functions equivalently. It would have been obvious to one of ordinary skill in the art to use an alternative known equivalent arrangement of placing the data carrier element containing IC chip on the side of the substrate which is in direct contact with the adhesive layer 17, which reads on the instant invention as claimed. It should be noted that the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

#### ***Response to Argument***

4. Referring to Office action mailed 3/3/2006, page 4, first paragraph, applicants stated at page 2, last paragraph that the examiner has agreed that the terms “electric circuit” and “electronic components” are two distinct and mutually exclusive terms. The examiner wish to clarify that in the quoted passage the examiner merely acknowledges the amendment to claims with specific electronic components is structurally clarifying: Specifically, in claim 1 the term “electronic components” has been amended as “IC chip”, and in claim 6, the same term “electronic components” has been further clarified as comprising “IC chip” and “antenna coil”, with their structural relationship also clarified. Nowhere has the examiner agreed to the terms “electric circuit” and “electronic components” as two distinct and mutually exclusive terms. In

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fact, it is inconceivable that an “electric circuit” is not formed of “electronic components”, and an “electronic components” would not have contained certain “electric circuit” inside. In the absence of a clear definition for these terms, Applicants’ argument appears to be semantic and unpersuasive.

Applicants argue (Remarks page 3) that the examiner’s interpretation that “the separately formed parts” includes electronic components is illogical. However, in the absence of an express definition in the specification regarding the scope of the terms “components” and “parts”, the examiner asserts that one of ordinary skill in the art of electronics would have recognized that the term electronic “components” is inherently the same as electronic “parts” for forming a data carrying electronic circuit, and the term logically includes both “IC chip” and “antenna coil”, as shown in Fig. 2 of Tanimura, applicants’ argument to the contrary is unpersuasive.

Applicants argue (Remarks page 4, third paragraph) that the examiner apparently relies on Fig. 3, which represents the embodiment for “Applicants’ admission”, of the instant application is improper. However, the relied upon passage is entirely from the “Background Art” section, applicants argument is unpersuasive.

Applicants argue (Remarks page 4, fourth paragraph) that there is no indication or suggestion that the adhesive layer 5 may be rearranged. However, there is no “adhesive layer 5” present in Tanimura’s invention, applicants’ argument is not understood.

Finally, applicants argue (Remarks page 5, third paragraph) that the Declaration by Mr. Masateru Yamakage demonstrates the unexpected superiority of the present invention and supports the patentability. However, since nowhere can a declaration by Mr. Masateru

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Yamakage be found with the present application, applicants' arguments relating to the declaration cannot be considered.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Victor S Chang  
Examiner  
Art Unit 1771

8/4/2006

  
TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
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